

REMARKS/ARGUMENTS

A PETITION FOR EXTENSION OF TIME has been filed, concurrently with this Amendment, extending the time for response to the Official Action three (3) months, from August 2, 2007, to November 2, 2007.

Claims 1-3, 5-7, 10-13, and 22-24 are under active consideration in the subject patent application.

In the Official Action, the Examiner has rejected claims 1-3, 5-7, 10-13, and 22-24 under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 2,118,676, issued to Lankton (the "Lankton" reference).

Applicant acknowledges with appreciation the Examiner's withdrawal of the prior objection to the drawings and prior rejections of pending claims under 35 U.S.C. §§ 112 and 102(b). Applicant traverses, however, the Examiner's continued reliance upon the disclosures in the Lankton reference to support an obviousness rejection under 35 U.S.C. § 103(a), and because the Examiner has not established a prima facie case of obviousness under controlling law, Applicant requests reconsideration and withdrawal of this rejection for the following reasons.

Section 103(a) provides that a patent may not be obtained if "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). As recently reaffirmed by the U.S. Supreme Court, the question of obviousness is resolved on the basis of underlying factual determinations including (1)

the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. See KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007) (citing Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)); id. ("While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls."). An additional step in the analysis is the consideration of "objective indicators of non-obviousness," which should be considered to understand the circumstances surrounding the origin of the subject matter sought to be patented.

These indicators have come to include:

- (1) commercial success of products covered by the patent claims;
- (2) a long-felt and unmet need for the invention;
- (3) failed attempts by others to make the invention;
- (4) copying of the invention by others;
- (5) unexpected results achieved by others;
- (6) praise of the invention;
- (7) interest in the taking of licenses to the subject matter by others;
- (8) expressions of surprise by experts at the making of the invention; and
- (9) that the inventor proceeded contrary to the accepted wisdom of the prior art.

See, e.g., Graham, 383 U.S. at 17-18; Eli Lilly & Co. v. Zenith Goldline Pharms., Inc., 471 F.3d 1369, 1380 (Fed. Cir. 2006); see also Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR

International Co. v. Teleflex Inc., 72 Fed. Reg. 57526, 57526-35 (Oct. 10, 2007) ("Obviousness Guidelines").

To support a rejection of claims under Section 103(a), the Examiner's obviousness analysis "should be made explicit." KSR, 127 U.S. at 1740-41, 82 USPQ2d at 1396; see also Ex parte Catan, Appeal 2007-0820, at 11 (B.P.A.I. July 3, 2007); Ex parte Smith, Appeal 2007-1925, at 14 (B.P.A.I. June 25, 2007). "Rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

Here, although the Examiner has generally alleged as obvious the combination of (a) a seat and (b) an aesthetic portion included in an edge of a back of the seat that is patterned to resemble one of a plurality of preselected scenic silhouettes of existing landscape contours, ridge profiles, or mountain ranges, the Examiner has not made any specific findings regarding (1) the scope and content of the prior art, particularly as regards the aesthetic portion; (2) the alleged lack of differences between the claimed subject matter and the prior art ; or (3) the level of skill in the art, as required by the above-cited case law. See Graham, 383 U.S. at 17-18. An express articulation of this analysis is necessary to affirm an obviousness rejection on review. See, e.g., Catan, Appeal 2007-0820, at 17 (articulating analysis); Smith, Appeal 2007-1925, at 17-18 (same).

Specifically, regarding (1), the Examiner has failed to demonstrate where each element recited in the claims is found in the applied reference. See Catan, Appeal

2007-0820, at 6-8 (stating findings of fact regarding the scope and content of prior art); Smith, Appeal 2007-1925, at 10-11 (same). Regarding (2), the Examiner has not alleged that there are no differences between the claimed subject matter and any identified elements in the prior art. See Catan, Appeal 2007-0820, at 19; Smith, Appeal 2007-1925, at 11. And regarding (3), the Examiner has not analyzed the state of the art of seating units or made any comment regarding the ordinary skill of artisans in the field. See Catan, Appeal 2007-0820, at 8-9 (analyzing the state of the relevant art); Smith, Appeal 2007-1925, at 17-18 (same). Because the Examiner has not articulated **any** of the above factors in the reasoning underlying what are otherwise mere conclusory statements of the alleged obviousness of the claims at issue, the Examiner has not established a prima facie case of obviousness under controlling law.

As the KSR Court noted, in conducting an obviousness analysis, it is often necessary "to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. Here, the Examiner has cited only one patent that clearly does not teach all the elements of the pending claims, and the Examiner has made no assertions regarding the effects of demands known to the design community or regarding the background knowledge possessed by a person of ordinary skill in the art.

The KSR Court has also suggested that the “operative question” in the obviousness inquiry is “whether [an alleged] improvement [over the prior art] is more than the predictable use of prior art elements according to their established functions.” Id.; see also Catan, Appeal 2007-0820, at 10 (noting “operative question”); Smith, Appeal 2007-1925, at 13 (same). Where the Examiner has failed (1) to identify any specific “prior art elements” in the alleged improvement, (2) to posit what the “established functions” of those prior art elements are, or (3) to assert that the alleged improvement constitutes a “predictable use” of those prior elements, a rejection of claims cannot be logically sustained.

Notwithstanding that the Examiner **has not** carried the burden of making out a prima facie case of obviousness under prevailing case law, Applicant submits that in view of evidence submitted herewith, in the form of a declaration under 37 C.F.R. § 1.132 made by Mr. Tom Phillips, Examiner **cannot** establish and sustain prima facie obviousness. As stated in the declaration, Mr. Phillips is an individual recognized as an expert in the field of rustic furniture design, manufacture, and repair. (See Decl. of Tom Phillips ¶¶ 2-6.) His expert skill in the field has been developed over 32 years of experience with furniture repair and over 24 years of experience with furniture design and manufacture. (See Decl. of Tom Phillips ¶¶ 2-3.) Mr. Phillips’ declaration is objective evidence that, from the perspective of one of expert skill in the art, there are significant differences between the Lankton chair and the subject matter of the claims at issue (see, e.g., id. ¶ 16) and that the subject matter of the claims at issue does not constitute a “predictable use” of prior elements. Applicant submits that, in view of this

evidence, the Examiner must offer particularly compelling contradictory evidence to sustain the obviousness rejection.

The Examiner has also failed to establish a prima facie case of obviousness under the traditional teaching, suggestion, motivation test ("TSM test"). MPEP § 2142; see also KSR, 127 S. Ct. at 1741 (noting that "[t]here is no necessary inconsistency between the idea underlying the TSM test and the Graham analysis" and suggesting that the TSM test remains viable as a "general principle" guiding the obviousness analysis). To establish a prima facie case of obviousness under the TSM test, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. Applicant has previously asserted, and the Examiner has not refuted, that Lankton fails to teach or suggest a back rest in a sitting device with a top edge having an aesthetic portion that resembles one of a plurality of preselected scenic silhouettes of existing landscape contours, ridge profiles, or mountain ranges. As noted above, Lankton fails to discuss this aspect of his chair at all! Moreover, Lankton's depiction of an arbitrary aesthetic contour at the top edge of the chair shown in his figures fails to suggest or provide any motivation for the use of an edge contour that resembles or is based upon preselected existing and naturally occurring scenic silhouettes. Lankton simply fails to teach or suggest all of Applicant's claim limitations.

Furthermore, even if the Examiner were to establish a prima facie case of obviousness, there are a number of objective indicators of non-obviousness that rebut such a prima facie case and firmly demonstrate that the subject matter of the claims at issue is, in fact, not obvious. Mr. Phillips' declaration includes objective observations regarding at least one embodiment of the claimed invention in the context of his expert experience and evidences several of the above-referenced "objective indicators of non-obviousness." See, e.g., Graham, supra page 9. For example, Mr. Phillips' declaration evidences that Applicant achieved "unexpected results" with the invention (see, e.g., Decl. of Tom Phillips ¶¶ 9, 10, 11, 12, 13, 14 & 18); that at least one individual of exceptional skill in the art has "praise [for] the invention" (see, e.g., id. ¶¶ 13, 14 & 18); that at least one "expert" expressed "surprise . . . at the making of the invention" (see, e.g., id. ¶¶ 13 & 14); and that "the inventor proceeded contrary to the accepted wisdom of the prior art" (see, e.g., id. ¶¶ 9, 10, 11, 12, 13, 14 & 18).

Additionally, the subject matter of the claims at issue was not the result of a combination of a "finite number of identified, predictable solutions" by a person of ordinary skill in the art motivated by common sense. See KSR, 127 S. Ct. at 1742. Rather, Applicant's combination of a seating unit and an aesthetic portion that resembles one of a plurality of preselected scenic silhouettes of existing landscape contours, ridge profiles, or mountain ranges is a truly innovative product realized from an infinite number of patterns that had not previously been identified as solutions.

Regarding the Examiner's assertions that the particular shape of the upper edge is considered a matter of design choice and has no patentable utility, Applicant submits

that there are a number of utilitarian features of the aesthetic portion of the back of the seating unit, including education of users and observers of the seating unit about the depicted landscape, especially where the back includes a descriptive message or a significant date, and memorialization in a fixed medium, albeit informally, of distinctive contours of a particular landscape for posterity and archival purposes.

In summary, Applicant submits that the unique apparatus defined by claims 1-3, 5-7, 10-13, and 22-24 is not disclosed in the prior art reference cited by the Examiner taken as a whole, that the Examiner has not established a prima facie case of obviousness by articulating (1) the scope and content of the prior art; (2) an alleged lack of differences between the claimed subject matter and the prior art ; or (3) the level of skill in the art, and that the objective evidence in the form of the declaration attached hereto demonstrates that the claims at issue are not obvious in any event. Claims 1-3, 5-7, 10-13, and 22-24 are patentable over the Lankton reference. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

If a telephone conference would be of assistance in advancing prosecution of the above-identified application, Applicant's undersigned Attorney invites the Examiner to telephone him at **215-979-1255**.

Respectfully submitted,

Dated: October 25, 2007

/Samuel W. Apicelli/
Samuel W. Apicelli
Registration No. 36,427
Customer No. 08933
DUANE MORRIS LLP
30 S. 17th Street
Philadelphia, PA 19103-4196
Tel.: (215)979-1255
Fax: (215) 979-1020
swapicelli@duanemorris.com